

REMARKS / ARGUMENTS

In this response, Applicant has canceled claim 5, amended claim 1, and added claim 8, to particularly point out certain novel features of the present invention. Applicant respectfully submits that the aforementioned changes do not add new matter, and that the amendments are supported by the originally filed specification. In particular, amended claim 1, adds limitations from claim 5, and new claim 8 recites the limitation that the length of the further road is substantially the same or greater than the at least one existing road from where traffic is to be routed. Applicant submits that these limitations are neither taught nor rendered obvious by Wright et al., the cited Louisiana road system, and Haakonsen, as detailed below.

Rejection Under 35 U.S.C. §103 As Unpatentable Over Wright et al. In View Of Cited Louisiana Road System

The Examiner has rejected claims 1-3, 5 and 6 under 35 U.S.C. §103(a) as unpatentable over Wright et al. in view of the cited Louisiana road system. Reconsideration thereof is requested in light of the following.

In objecting to claims under 35 U.S.C. 103, reasons why one of ordinary skill in the art would have been to arrive at the claimed invention must be provided. To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from applicant's disclosure. See for example, *Uniroyal, Inc. vs. Rudkin-Wyle Corp.* 837 F2d, 7, USPQ, 2d 1434 (Federal Circuit 1988). Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. It is submitted that without the benefit of applicant's disclosure, a skilled artisan would not be motivated by the prior art of record in any way to provide the method as now claimed in the instant application.

Moreover, applicant submits that its invention as claimed is not only different from Wright et al. in view of the cited Louisiana road system, but provides substantial advantages ther over that are unobvious from the art of record.

Bridges are conventionally used to connect two non-contiguous bodies of land, such as a mainland to an island. Bridges are also conventionally used to connect two points on a contiguous body of land to reduce the distance required to travel therebetween. The Louisiana road system cited by the Examiner is an example of the latter.

In the Louisiana road system cited by the Examiner, the distance required to travel from Metairie to Mandeville via the bridge is much shorter than any of the possible existing routes overland. Thus, although it is possible to travel between these towns overland, the bridge drastically reduces the commute time. Applicant suspects that this was the motivation for building the bridge in the first place. If the distance overland had been shorter (or even approximately equal to the length of the bridge), conventional wisdom would suggest that it would have been ludicrous to build the bridge.

And yet, as non-obvious as it may appear, there are circumstances outlined in the present invention where building a bridge that is typically as long—if not longer—as any overland route would be desirable. In particular, as shown in the example of the detailed description of the present invention, building a “bridge” that remains substantially parallel to the shoreline over its length, and is therefore approximately equal or greater in length than the route overland (i.e., the “at least one existing road”) can be used to diminish traffic.

The Applicant has added the limitation of canceled claim 5 to claim 1. In particular, the limitation that the further road be generally parallel over its length to the shoreline implies that the length of the further road is usually equal to or greater than the length of the shoreline. (The Examiner is asked to convince himself of the geometric fact that if the shoreline and the further road are truly parallel, then it follows that the length of the further road is approximately equal to or greater than the shoreline.)

In short, Applicant suggests that, absent what is taught in the present invention, a person of ordinary skill in the art would conclude that it is not worth building the further road over water if alternate shorter routes are available overland. At the very least, it would not be obvious to the person to consider such a proposal had it not been suggested.

As mentioned, the cited reference do not deal with the proximate problem of routing traffic by constructing a further road is generally parallel over its length to the shoreline of the body of water and the tract of land to route traffic. As mentioned, the Louisiana road system is a bridge to reduce commute time between two points. Since neither this reference nor Wright et al. is concerned with the same proximate problem as the invention, there can be no *prima facie* case of obviousness by modifying these references, either singly or in combination to provide the invention as discussed above. Moreover, should one modify the Louisiana road system according to applicants invention, applicant submits that the purpose or function of the bridge disclosed in that reference would be destroyed, i.e., providing a shorter route than any of the possible overland routes. Since there would be no technological motivation for engaging in the modification or change (in fact, applicant submits there would be a disincentive), an obviousness rejection under §103 is not proper. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Therefore, claim 1, as amended, is neither taught in nor rendered obvious by Wright et al. in view of the cited Louisiana road system. Accordingly, favorable consideration of claim 1, and of claims 2, 3, 6, 7, and 8, which depend from claim 1, is solicited.

Rejection Under 35 U.S.C. §103 As Unpatentable Over Wright et al. In View Of
Haakonsen (5,216,773)

The examiner has rejected claim 7 under 35 U.S.C. §103(a) as unpatentable over Wright et al. in view of Haakonsen. Reconsideration thereof is requested in light of the following.

Claim 7 depends from claim 1, which now includes the limitation that the further road and the shoreline be generally parallel. As mentioned above, this implies that the further road, which is located above the body of water, is longer than the shoreline and the nearby existing road. Applicant suggests that, absent what is taught in the present invention, someone of ordinary skill in the art would conclude that it is not worth building the further road over water if alternate shorter routes are available overland. The present invention is not suggested by Wright et al. and Haakonsen. Accordingly, favorable consideration of claim 7 is solicited.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Should the Examiner have any further issues outstanding, applicant invites the Examiner to call the undersigned at (416) 957-1697.

Respectfully submitted,

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